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ACCENTURE CHICAGO 28164 BRINKS HOFER GILSON & LIONE P O BOX 10395 CHICAGO IL 60610

MAILED

JUN 10 2011

OFFICE OF PETITIONS

In re Application George V. Guyan et al. Application No. 09/305,146 Filed: May 4, 1999

DECISION ON APPLICATION

: FOR PATENT TERM ADJUSTMENT

Attorney Docket No. 10022/252

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) filed November 22, 2010. Applicant requests that the determination of patent term adjustment be corrected from 1118 days to 1141 days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

On October 19, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 1118 days. The instant application for patent term adjustment was timely filed<sup>1</sup> on or before payment of the issue fee.

Applicants argue that the Patent Office erroneously assigned a filing date of January 9, 2003 to the Request for Continued Examination (RCE) filed on October 7, 2002 and as a result, a period of adjustment pursuant to 37 C.F.R. § 1.703(a)(3) should be increased by 39 days.

A review of the application history reveals that applicants are correct. The Office incorrectly entered the date of receipt of the RCE in the PTA Calculations as January 9, 2003 instead of October 7, 2002. Thus, the date of October 7, 2002, not January 9, 2003, should have been used for the purposes of calculating patent term adjustment.

In view thereof, in response to the Office Action mailed May 6, 2002, a delay of 62 days on the part of Applicants should be calculated for the period from August 6, 2002 to October 7, 2002, pursuant to 37 CFR 1.704(b). Thus 156 days will be removed and 62 days will be entered. As well, for the period October 7, 2002 to March 18, 2003, when the non-Final Office Action was mailed, a period of 39 days has been entered for Examination delay pursuant to 37 CFR 1.702,(a)(2).

<sup>&</sup>lt;sup>1</sup> PALM records indicate that the issue fee was paid on November 22, 2010.

Applicants argue also that the after the filing of a response on June 19, 2003, not June 18, 2003, to a non-Final Office Action mailed March 18, 2003, the period of adjustment pursuant to 37 C.F.R. § 1.703(a)(2) is the number of days in the period beginning on the day ("the four month date") after that date that is four months after the date a reply in compliance with 37 CFR § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever comes first. Applicants argue the four month date should have been October 19, 2003 not October 18, 2003 as calculated by the Office and as such, the period of delay should be 25 days and not 26 days. Thus 26 days is being removed and 25 days is being entered for the delay pursuant to 37 CFR 1.702(a)(2).

Applicants argue that the Patent Office has calculated two hundred forty eight (248) days of delay for failing to mail the Examiner's Answer by March 13, 2007 and that instead, there should be a delay of one hundred thirty nine (139) days on the part of the Patent Office since the delay is incorrectly based on the July 24, 2006 filing of the non-compliant Appeal Brief. Thus, the Patent Office has calculated 109 days of too much delay on its part regarding this matter.

There is no calculation of 248 days in the record and thus applicants' argument is not supported. However, a review of the record reveals calculations for a 1140 day period of Office delay, beginning on April 27, 2006 with the filing of the Notice of Appeal and ending on June 9, 2009 and, a 2 day period of delay accorded for Office delay from July 28, 2006 to July 30, 2006 has been entered. The Office erred in according both 1140 days of adjustment for Office delay in issuing a Board decision, pursuant to 37 CFR 1.703(e) and 2 days of adjustment for Office delay in issuing an Examiner's answer, pursuant to 37 CFR 1.703(a)(3) 2007. This period totally overlaps with the Office delay in issuing the Board of Patent Appeals and Interferences decision, which begins on April 27, 2006 and ends on June 9, 2009. Accordingly, only a period of adjustment of 1140 days should have been entered. The period of adjustment of 2 days is being removed.

Thus the patent term adjustment at the time the Notice of Allowance was mailed was 1002 days (96 "A delay" days + 1140 "C delay" days - 234 Applicant delay days), not 1141 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is ONE THOUSAND TWO (1002) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at

the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Bàll Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of Revised PALM Screen



# Patent



PTA/PTE Information Patent <u>Term Adjustment</u>

Application Number\*: 09305146 Search: Explanation of PTA Calculation Explanation of PTE Calculation

### PTA Calculations for Application: 09305146

:	Application Filing Date 05/04/1999	OverLapping Days Between (A and B) or (A and C)			
	Issue Date of Patent	Non-Overlapping USPTO Delays: 1200			
ž	A Delays 60	PTO Manual Adjustment 130			
	B Delays 0	Applicant Delay (APPL) <sub>328</sub>			
	C Delays 1140	Total PTA (days) 1002			

### \* - Sorted Column

## File Contents History

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Action Yumber	Action Recorded Date	Action Due Date	Action Code	<u>Action</u> <u>Description</u>	<u>Duration</u> <u>PTO</u>	Duration APPL		Parent Action Numbe
35	06/09/2011		P028	Adjustment of PTA Calculation by PTO		62	0	11,11111111
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33	06/09/2011		P028	Adjustment of PTA Calculation by PTO	39		o	
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	03/04/2011		IREV	Issue Revision Completed			ō	
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	03/02/2011		CNTA	Allowability Notice			n	
	02/28/2011		ABN9	Disposal for a RCE / CPA / R129			0	
	02/22/2011		MP006	Mail-Record Petition Decision of Granted to Withdraw from			0	
95	02/22/2011		P006	Record Petition Decision of Granted to Withdraw from Issue			0	
	02/22/2011		TCPB	Printer Rush- No mailing			0	
	02/18/2011		IDSC	Information Disclosure Statement considered			0	
	02/18/2011		RCAP	Reference capture on IDS			0	
	02/18/2011		M844	Information Disclosure Statement (IDS) Filed			0	
	02/18/2011		RCEX	Request for Continued Examination (RCE)			0	
			PET.	Petition Entered			0	
	02/18/2011		WIDS				0	
	02/18/2011			Information Disclosure Statement (IDS) Filed			-	
	02/18/2011		BRCE	Workflow - Request for RCE - Begin			0	
	11/24/2010		PILS	Application Is Considered Ready for Issue			0	
	11/22/2010		N084	Issue Fee Payment Verified			0	
	11/22/2010		PET2	Petition Entered			0	
	11/22/2010		IFEE	Issue Fee Payment Received			0	
	10/22/2010		EIDC	Export to Initial Data Capture			0	
	10/19/2010		MN/=.	Mail Notice of Allowance			0	
	10/19/2010 .		IREV	Issue Revision Completed			0	
	10/19/2010		DVER	Document Verification			0	
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81	10/19/2010		CNTA	Allowability Notice			0	
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74         02/21/2006         CTFR         Final Rejection         0           73         12/07/2005         FWDX         Date Forwarded to Examiner         0           72         11/22/2005         A         Response after Non-Final Action         0           71         10/06/2005         DOCK         Case Docketed to Examiner in GAU         0           70         08/23/2005         MCTNF         Mail Non-Final Rejection         0           69         08/22/2005         CTNF         Non-Final Rejection         0           68         06/07/2005         FWDX         Date Forwarded to Examiner         0           66         06/07/2005         ABNP         Disposal for a RCE / CPA / R129         0           67         05/31/2005         O4/21/2005 RCEX         Request for Continued Examination (RCE)         40         59           65         05/31/2005         XT/G         Request for Extension of Time - Granted         0         0           64         05/31/2005         BRCE         Workflow - Request for RCE - Begin         0         0           63         04/28/2005         MCTAV         Mail Advisory Action (PTOL - 303)         0         0           61         03/29/2005         FWDX         D	11 11 11 11 11 11 11 11 11 11 11 11 11	107 106 103 101 101 106 105 104 107 107 108 108 108 108 108 108 108 108 108 108	02/05/2008 12/17/2007 12/15/2007 10/18/2007 10/18/2007 08/30/2007 07/30/2007 07/30/2007 03/20/2007 03/20/2007 03/20/2007 12/18/2006 11/20/2006 11/20/2006 11/20/2006 11/20/2006 11/20/2006 11/30/2006 11/30/2006 11/30/2006 01/20/2006 01/20/2006 07/24/2006 07/24/2006 07/24/2006 06/22/2006	07/28/2007	WIDS MRBNE RBNE RBNE FWDX APRB PACC MAPEA APEA APBD APBD TWDX IDSC RCAP WIDSC RCAP WIDS APBI APBI APBI APBI APBI APBI APBI APBI	Information Disclosure Statement (IDS) Filed Mail Reply Brief Noted by Examiner Reply Brief Noted by Examiner Date Forwarded to Examiner Reply Brief Filed Exam. Ans. Review Complete Mail Examiner's Answer Examiner's Answer to Appeal Brief Date Forwarded to Examiner Appeal Brief Filed Notice Defective Appeal Brief Appeal Brief Review Complete Date Forwarded to Examiner Information Disclosure Statement considered Reference capture on IDS Information Disclosure Statement (IDS) Filed Information Disclosure Statement (IDS) Filed Defective / Incomplete Appeal Brief Filed Appeal Brief Filed Notice Defective Appeal Brief Date Forwarded to Examiner Defective / Incomplete Appeal Brief Date Forwarded to Examiner Defective / Incomplete Appeal Brief Filed Appeals Brief Filed Nail Appeals conf. Proceed to BPAI Pre-Appeals Conference Decision - Proceed to BPAI Request for Pre-Appeal Conference Filed	2	122	0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0
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58	01/21/2005	12/20/2004		Mail Final Rejection (PTOL - 326)	<u>32</u>		56 0
57	01/18/2005		CTFR	Final Rejection			-
55	11/17/2004		FWDX	Date Forwarded to Examiner			0
56	10/13/2004		DOCK	Case Docketed to Examiner in GAU			0
1	08/20/2004		A	Response after Non-Final Action			0
54	08/20/2004		WAMD	Workflow incoming amendment IFW			0
53	05/20/2004		MCTNF	Mail Non-Final Rejection			0
52 51	05/17/2004		CTNF	Non-Final Rejection			0
_	03/10/2004		FWDX	Date Forwarded to Examiner			0
49	03/10/2004		FWDX	Date Forwarded to Examiner			0
47	03/10/2004	-	ABN9	Disposal for a RCE / CPA / R129			0
50	02/17/2004		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			0
48	02/17/2004	02/13/2004		Request for Continued Examination (RCE)		<u>4</u>	45
46	02/17/2004		BRCE	Workflow - Request for RCE - Begin			0
45	11/13/2003	10/18/2003		Mail Final Rejection (PTOL - 326)	<u> 26</u>		42
44	11/13/2003		CTFR	Final Rejection			0
43	09/15/2003		FWDX	Date Forwarded to Examiner			0
105	06/19/2003		IDSC	Information Disclosure Statement considered			0
100	06/19/2003	06/18/2003		Information Disclosure Statement (IDS) Filed		1	42
99	06/19/2003		WIDS	Information Disclosure Statement (IDS) Filed			0
42	06/18/2003		A	Response after Non-Final Action			0
41	03/18/2003		MCTNF	Mail Non-Final Rejection			0
40	03/10/2003		CTNF	Non-Final Rejection			0
38	01/14/2003		FWDX	Date Forwarded to Examiner			0
36	01/14/2003		FWDX	Date Forwarded to Examiner			0
34	01/14/2003		ABN9	Disposal for a RCE / CPA / R129			0
39.7	01/09/2003	01/09/2003		Information Disclosure Statement (IDS) Filed			35
39	01/09/2003		WIDS	Information Disclosure Statement (IDS) Filed			0
37	01/09/2003		SA	Supplemental Response			0
35	01/09/2003	08/06/2002		Request for Continued Examination (RCE)		<u>156</u>	24
33	01/09/2003		XT/G	Request for Extension of Time - Granted			0
32	01/09/2003		BRCE	Workflow - Request for RCE - Begin			0
31	07/23/2002		MCTAV	Mail Advisory Action (PTOL - 303)			0
29	07/23/2002		MCTAV	Mail Advisory Action (PTOL - 303)			0
30	07/22/2002		CTAV	Advisory Action (PTOL-303)			0
28	07/22/2002		CTAV	Advisory Action (PTOL-303)			0
27	07/19/2002	•	FWDX	Date Forwarded to Examiner			0
26	07/03/2002		A.NE	Amendment after Final Rejection			0
25	06/03/2002		DOCK	Case Docketed to Examiner in GAU			0
24	05/06/2002		MCTFR	Mail Final Rejection (PTOL - 326)			0
23	05/06/2002		CTFR	Final Rejection			0
21	04/25/2002		FWDX	Date Forwarded to Examiner			0
19	04/25/2002		ABN9	Disposal for a RCE / CPA / R129			0
17	04/23/2002		DOCK	Case Docketed to Examiner in GAU			0
22	04/19/2002		A.PE	Preliminary Amendment			0
20	04/19/2002		ACPA	Continuing Prosecution Application - Continuation (ACPA)			0
18	04/19/2002		XT/G	Request for Extension of Time - Granted			0
16	04/19/2002		BRCE	Workflow - Request for RCE - Begin			0

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